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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,138	11/25/2002	Saliha Moussaoui -Mrabet	43550	1464

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EXAMINER	
FALK, ANNE MARIE	
ART UNIT	**PAPER NUMBER**
1632	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/088,138	MOUSSAOUI -MRABET ET AL.	
	Examiner	Art Unit	
	Anne-Marie Falk, Ph.D.	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) *11,12 and 14* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10 and 13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/23/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The response filed June 8, 2006 has been entered.

The preliminary amendment filed March 15, 2002 has been entered. Claims 10-12 were amended. Claims 13 and 14 were newly added.

Accordingly, Claims 1-14 are pending in the instant application.

Applicants' election with traverse of Group I, Claims 1-10 and 13, in the response filed June 8, 2006 is acknowledged. Applicants further elected the M146L mutation of PS1 and an APP gene comprising the combination of Swedish, London, and Dutch mutations. The elected invention is drawn to (i) a non-human transgenic animal model of Alzheimer's disease which exhibits both amyloid plaques and mitochondrial dysfunction, and (ii) a method for identifying compounds for treating neurodegenerative diseases using the transgenic animal model.

The traversal is on the grounds that the there is a special technical feature linking the inventions of Groups I and II because the cell of Claim 11 is extracted from the transgenic animal having the same genetic makeup. However, the genetic makeup is not a special technical feature linking the inventions because the complete genetic makeup is not recited in the claims, and thus there is no limitation to a specific genetic makeup. Furthermore, the particular mutations recited in the claims are not a contribution over the prior art, as noted in the rejection set forth herein, and therefore do not rise to the level of a special technical feature.

The requirement is still deemed proper and is therefore made FINAL.

Claims 11, 12, and 14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Election was made with traverse in the response filed February 13, 2006.

Claims 1-10 and 13 are examined herein.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/17782 (Duff et al., published April 30, 1998).

Duff et al. (1998) disclose a transgenic mouse comprising a PS1 gene having the M146L mutation and further comprising an APP gene of the APP695 isoform having the mutations K670N and M671L (Swedish mutation). The double transgenic mice exhibit amyloid plaques (see Table 1 at page 23) and behavioral deficits consistent with an Alzheimer's disease model. The reference is silent with regard to a mitochondrial dysfunction. However, when the structure disclosed in the prior art is substantially identical to that claimed, claimed properties are presumed inherent.

MPEP § 2112(III) states that a rejection under 35 U.S.C. 102/103 can be made when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic. Here, the prior art is silent with respect to mitochondrial dysfunction.

The MPEP states that the "express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103." MPEP § 2112. Also see the decision of *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) which states that

"[t]he inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." The MPEP further emphasizes that the "inherent feature need not be recognized at the time of the invention" (MPEP § 2112).

MPEP § 2112 explicitly states the following:

> "SOMETHING WHICH IS OLD DOES NOT BECOME PATENTABLE UPON THE DISCOVERY OF A NEW PROPERTY
> 'The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer.' *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus, the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)."

The MPEP further teaches that "once a reference teaching product appearing to be substantially identical is made the basis of a rejection, and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference." MPEP § 2112. In the instant case, no evidence has been presented to show that the prior art product does not necessarily or inherently possess the characteristics of the claimed animal.

In the decision of *In re Spada*, 15 USPQ2d 1655 (CAFC 1990) the court points out that discovery of a new property or use of a previously known composition, even if unobvious from prior art, cannot impart patentability to claims to known compositions. The transgenic animal claimed constitutes "a previously known composition."

Thus, the claimed invention is disclosed in the prior art.

Conclusion

No claims are allowable.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent

Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Falk whose telephone number is (571) 272-0728. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735. The central official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Anne-Marie Falk, Ph.D.

Anne-Marie Falk

ANNE-MARIE FALK, PH.D
PRIMARY EXAMINER